REMARKS

In the Office Action[1], the Examiner rejected claims 1, 3, 6, 7, and 10 under

35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Pub. No.

2004/0019822 to Knapp III ("*Knapp*"); and rejected claims 2, 4, and 5 under 35 U.S.C. §

103(a) as being unpatentable over *Knapp*.

Applicant has amended claims 1-5, 7, and 10 and canceled claim 6. Claims 1-5

and 7-10 remain pending, and claims 8 and 9 have been withdrawn.

In a telephone conference on September 11, 2006, the Examiner required

restriction under 35 U.S.C. § 121 between the following groups of claims:

> Group I. Claims 1-7 and 10, characterized by the Examiner as directed to
>
> a setup support system and method; and
>
> Group II. Claims 8 and 9, characterized by the Examiner as directed to a
>
> physical access driver.

Applicant's representative provisionally elected Group I, claims 1-7 and 10, for

examination on the merits. Applicant confirms the election of claim 1-7 and 10.

I. Regarding the rejections of claims 1, 3, 6, 7, and 10 under
35 U.S.C. §102(e) as being anticipated by *Knapp*

Applicant respectfully traverses the rejection of claims 1, 3, 6, 7, and 10 under

35 U.S.C. § 102(e) as anticipated by *Knapp*. In order to properly establish that *Knapp*

anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every

element of each of the claims in issue must be found, either expressly described or

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

under principles of inherency, in that single reference. Furthermore, "[t]he identical

invention must be shown in as complete detail as is contained in the ... claim." *See*

M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites a setup support system comprising, for example:

> . . .
>
> . . .
>
> a setting parameter management unit configured to store setting parameters representing input setting contents in at least one of the storage mediums <u>before the construction of the RAID configuration by using the physical access unit</u>;
> a medium setting unit configured to construct the RAID configuration <u>while accessing the setting parameters stored in the at least one of the storage mediums by using the physical access unit</u>; and
> a setup unit configured to execute setup of the computer <u>after the construction of the RAID configuration, including generation of a disk partition in each of the storage mediums where the RAID configuration is constructed and installation of the operating system, while accessing the setting parameters stored in the at least one of the storage mediums by using the physical access unit</u>.

(emphasis added). *Knapp* does not disclose at least these elements of

Applicant's claimed invention.

Knapp discloses "a method for implementing a redundant storage system which

simplifies the configuring and implementing of a RAID data storage system" (paragraph

0010). In *Knapp*, a system is constructed upon receipt of the instruction of the system

configuration, and a RAID-1 configuration is constructed upon receipt of the instruction

regarding the RAID-1 configuration at the time of the installation of the operating

system.

In contrast, claim 1 recites "a setting parameter management unit configured to

store setting parameters representing input setting contents in at least one of the

storage mediums <u>before the construction of the RAID configuration</u> by using the physical access unit." *Knapp* does not teach or suggest these claim elements. Moreover, *Knapp* also does not teach or suggest the claimed combination of elements, including, for example, "a setup unit configured to execute setup of the computer after the construction of the RAID configuration, including generation of a disk partition in each of the storage mediums where the RAID configuration is constructed and installation of the operating system, while accessing the setting parameters stored in the at least one of the storage mediums by using the physical access unit," as further recited in claim 1.

Accordingly, *Knapp* cannot anticipate claim 1. Claims 3 and 7 depend from claim 1 and are thus also allowable over *Knapp* for at least the same reasons as claim 1. Independent claim 10, while of different scope, recites elements similar to those of claim 1 and is thus allowable over *Knapp* for at least the same reasons discussed above with respect to claim 1.

II. Regarding the rejection of claim 2, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over *Knapp*

Applicant respectfully traverses the rejection of claims 2, 4, and 5 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In*

re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P.
§ 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among

other things, *Knapp* does not teach or suggest each and every element recited by

claims 2, 4, and 5.

Claims 2, 4, and 5 depend from claim 1 and therefore include all of the elements

recited therein. The Examiner admits that *Knapp* "does not mention that the BIOS is

controlling the physical access" and "does not store the parameters again" (Office

Action at page 6). However, the Examiner relies on "official notice" and "ordinary skill"

to teach the claim elements (Office Action at page 6).

Even assuming these allegations are true, which Applicant does not concede,

"official notice" and "ordinary skill" fail to cure the deficiencies of *Knapp* discussed

above. As previously stated, *Knapp* does not teach or suggest the claimed combination

of elements, including "setting parameter management unit configured to store setting

parameters representing input setting contents in at least one of the storage mediums

before the construction of the RAID configuration by using the physical access unit,"

and "a setup unit configured to execute setup of the computer after the construction of

the RAID configuration, including generation of a disk partition in each of the storage

mediums where the RAID configuration is constructed and installation of the operating

system, while accessing the setting parameters stored in the at least one of the storage

mediums by using the physical access unit," as recited in claim 1 and required by

dependent claims 2, 4, and 5.

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Because *Knapp* fails to teach or suggest each and every element recited in independent claim 1 and required by dependent claims 2, 4, and 5, no *prima facie* case of obviousness has been established with respect to claims 2, 4, and 5. The rejection of claims 2, 4, and 5 under 35 U.S.C. § 103(a) based on *Knapp* is therefore improper.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 23, 2007   By: _____ Reg. No. 53,232
                                    Richard V. Burgujian
                            for Reg. No. 31,744